REMARKS

Rejection of claims 66 to 82 35 U.S.C. § 102(e) as being anticipated by Ebner, *et al.*, U.S. 2003/0003545

Claim 66 to 82 remain rejected under 35 U.S.C. § 102(e) as being anticipated by Ebner, *et al.*, U.S. 2003/0003545 ("Ebner et al."). The rejection has been made final.

Applicants submit that the rejection over Ebner et al., as well as the finality of the rejection, is improper for at least the following reasons.

According to the Examiner, the declaration filed under 37 CFR §131 in Applicant's October 31, 2003 response was ineffective in overcoming the § 102(e) rejection based on Ebner et al. The Examiner stated that a § 131 declaration is inappropriate when the reference is "claiming" the same patentable invention. However, as the examiner pointed out in the rejection, the Ebner et al., reference that was the basis of the §102(e) rejection set forth in the Office Action dated January 29, 2004 (i.e., U.S. 2003/0003545) has been abandoned and is no longer pending. Therefore, Ebner et al., cannot properly be considered as "claiming" the same patentable subject matter as the current application. *See* 37 CFR § 131(a)(1) which states in pertinent part that "prior invention may not be established under this section if either: (1) the rejection is based upon a... U.S. patent application publication of a *pending* or patented application to another [emphasis added]...." Accordingly, as Ebner is no longer a pending application, the § 131 declaration submitted by the Applicant is effective to antedate the Ebner et al., reference relied upon by the Examiner. Applicant also notes that if the § 131 declaration is not considered, it will have no effective means of challenging the sufficiency of the relied upon Ebner et al., reference, as an interference cannot be properly provoked with an abandoned application. *See, e.g.,* MPEP §§ 2303 and 2304.

Applicants also note that the Examiner agreed that Ebner et al., "cannot be given a prior art effective filing date as of the date of the provisional application 60/087,340 (May 29, 1998) because the anticipating sequence (SEQ ID NO:29) was not disclosed in [that] application. Ebner's SEQ ID NO:29 first appeared in the provisional application 60/099,805, filed September 10, 1998...." *See* Office Action dated February 10, 2004. The § 131 declaration filed by the Applicant on October 31, 2003 demonstrates that relevant work was carried out prior to Ebner's September 10, 1998 filing date. Accordingly, Applicants submit that Ebner et al., is not prior art

to the presented claims under §102(e) and as such, cannot be relied upon to support a § 102(e) rejection of said claims. Applicants respectfully request the Examiner to withdraw the final rejection of claims 66 to 82 under § 102(e) rejection based on Ebner et al.

In the January 29th Office Action, the Examiner also noted the existence of a divisional application filed by Ebner et al., (U.S. Publication No. 2003/0092133 A1) ('133 publication), that claims the same priority as the relied upon Ebner et al., publication. The Examiner also noted that this application remains pending and may claim, in part, the same subject matter as the currently rejected claims. However, the current rejection, which has been made final, is not based on the '133 publication. Applicants submit that if the examiner deems a new rejection to be appropriate over the newly identified Ebner et al., publication (i.e., the '133 publication), such a rejection should be made in a non-final Office Action. *See* MPEP § 706.07(a), (c) and (d).

Respectfully submitted,
for GENENTECH, INC.

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